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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/105,150	06/26/1998	ANGELO T. DONFRANCESCO	36087	5213
23820	7590	03/05/2004	EXAMINER	
ROYLANCE, ABRAMS, BERDO & GOODMAN, LLP 1300 19TH STREET, NW SUITE 600 WASHINGTON, DC 20036-2680			FIGUEROA, FELIX O	
			ART UNIT	PAPER NUMBER
			2833	

DATE MAILED: 03/05/2004

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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Paper No. 20040218

Application Number: 09/105,150  
Filing Date: June 26, 1998  
Appellant(s): DONFRANCESCO ET AL.

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Mark S. Bicks  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed November 14, 2003.

**(1) *Real Party in Interest***

A statement identifying the real party in interest is contained in the brief.

**(2) *Related Appeals and Interferences***

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

**(3) *Status of Claims***

The statement of the status of the claims contained in the brief is incorrect. A correct statement of the status of the claims is as follows:

The Examiner hereby withdraws the rejection on claim 5. Thus, claim 5 is now objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 1, 4, 6-16 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Crowther (US 3,068,445) in view of Josephson (US 5,181,310).

**(4) *Status of Amendments After Final***

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) *Summary of Invention***

The summary of invention contained in the brief is correct.

**(6) Issues**

The appellant's statement of the issues in the brief is substantially correct. The changes are as follows:

Claim 5 is objected to as previously stated in this Examiner's Answer.

**(7) Grouping of Claims**

Appellant's brief includes a statement that claims 1, 4, 6-14 and 18 do not stand or fall together.

**(8) Claims Appealed**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(9) Prior Art of Record**

3,068,445	Crowther	9-1959
5,181,310	Josephson	1-1993

**(10) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1, 4, 6-16 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Crowther (US 3,068,445) in view of Josephson (US 5,181,310).

Crowther discloses a terminal assembly (10) comprising a terminal base (12) having a bore (18) with an internal thread, a screw (16) having a shank (24) with opposite first and second ends and with an external thread (26), and having a head (22) on the first end, and a deformation (36) in a portion of the external thread adjacent the second end forming a stop to limit removal of the screw from the bore. However, Crowther does not show the deformation being a stake.

Crowther discloses substantially the claimed invention except for the deformation being a stake. Josephson shows (in Fig.6) that a deformation at a second end of a shank being a stake (col.4, lines 9-11) extending along a chord transverse to the longitudinal axis of the shank is an art recognized equivalent structure for deformation of Crowther. Therefore, because these two deformations were art-recognized equivalents at the time the invention was made, one of ordinary skill in the art would have found it obvious to substitute of the deformation of Josephson for the deformation of Crowther to prevent the screw from disengaging the terminal base.

Crowther also discloses a backing plate (14) having a central aperture receiving the shank and positioned between the head and the base, the backing plate comprising two depending tabs (30) being slidably received on openings (20) on the base, and a contact (34) extending from the base. Crowther also shows the axial length of the external thread being greater than the axial length of the internal thread.

Specifically on claims 4 and 16, it would have been an obvious matter of design choice to offset the deformation/stake from the longitudinal axis of the shank, since appellant has not disclosed that such arrangement solves any stated problem or is for any particular purpose and it appears that the invention would perform equally well with regardless of the location of the deformation/stake with respect to the longitudinal axis of the shank, e.g. as shown by Josephson.

**(11) Response to Argument**

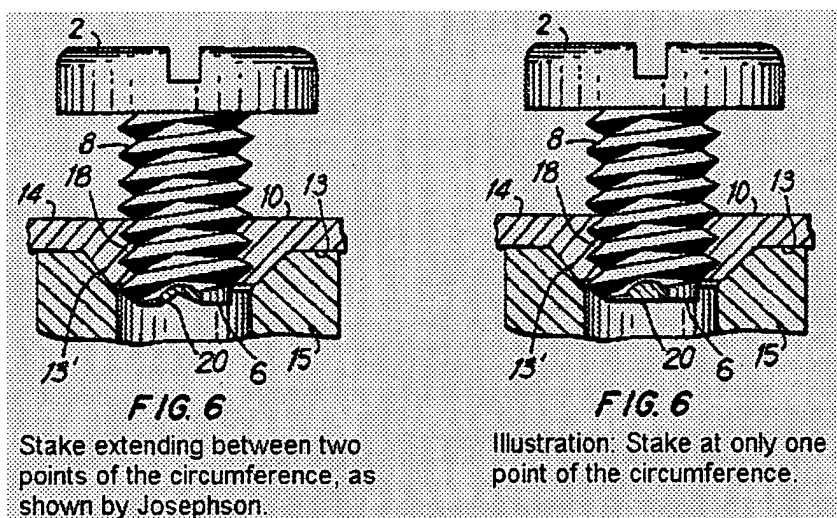
In response to appellant's arguments (starting in page 5) that Crowther "does not disclose, teach or render obvious a stake extending in the circular and substantially planar end of a screw shank and along a chord of the second end transverse to the

longitudinal axis of a screw", please note that one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In this case, the limitations missing in Crowther are taught by Josephson, as explained in the preceding Office action and further discussed below.

In response to appellant's arguments that Josephson "does not disclose, teach or render obvious a stake extending in the circular end substantially planar end of a screw shank and along a chord of the second end transverse to the longitudinal axis of a screw", please note that Josephson teaches (in col.4 lines 7-14, and Fig.6) a stake (20 / col.4, line 9) extending in the circular and substantially planar end (6) of a screw shank and along a chord (in a direction towards the page of Fig.6) of the second end transverse to the longitudinal axis of a screw.

In response to appellant's arguments (starting in the last paragraph of page 6) that "[t]o render a stake that extends along a chord obvious, the Josephson patent would have to teach a stake that extends along a bottom of a screw that deforms threads at two circumferentially spaced locations, and prevents the screw from backing out of a hole", it is noted (without conceding that Josephson does not teaches deformation at two locations) that the claim(s) only require that a stake "extending along a chord", not the entire length of a chord. Consequently, even if Josephson does not teach deformation at two locations, it still shows the stake (20) extending along part of the length of a chord, thus meeting the required claim language.

In response to appellant's arguments (in the first full paragraph of page 7) that "[t]he partial sectioned view of Fig. 6 does not clearly indicate whether the stake is partially or wholly on the side surface of the screw, and does not show that the stake extends to two spaced points on the circumference of the screw bottom, i.e., to be along a chord, as claimed", it is noted that even though the claims do not required the stake extending to two spaced points on the circumference of the screw bottom, Josephson teaches such limitations. First, it is noted that although Figure 6 shows the base 10 in cross-section, it shows a side view of the screw, i.e. not a cross-section. Additionally, the brief description of Figure 6 (col.2 lines 40-42) indicates that only the base / insert 10 is shown in cross-section. Finally, since the stake shown by Josephson provides a clear view from one side to the other of the screw, indicating that the stake extends to and intersects the circumference of the screw bottom at two spaced points. Please note that a stake intersecting the circumference will not allow vision from one side to the other. See the following illustration.



Nonetheless, and without conceding that Josephson does not show the stake extending to two spaced points of the bottom of the screw, it is noted that the claim language only requires that a stake "extending along a chord", not the entire length of the chord.

In response to appellant's argument (in the first full paragraph of page 8) that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the appellant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). In this case, Josephson teaches a deformation at a second end of a shank being a stake extending along a chord transverse to the longitudinal axis of the shank to prevent the screw from disengaging the terminal base (Fig.6 and col.4, lines 9-11).

Appellant argues (in page 8) that the references do not disclose the features of the dependent claims. Regarding claim 4, please note that it would have been an obvious matter of design choice to one of ordinary skill in the art at the time of the invention to offset the deformation/stake from the longitudinal axis of the shank, since appellant has not disclosed that such arrangement solves any stated problem or is for any particular purpose and it appears that the invention would perform equally well with regardless of the location of the deformation/stake with respect to the longitudinal axis of the shank.



Additionally, please note that (as disclosed in the previous Office action) Crowther also discloses a backing plate (14) having a central aperture, as required by claims 6-8 and 12-14; a contact (34) extending from the base, as required by claims 9 and 15; the axial length of the external thread being greater than the axial length of the internal thread (Fig.2), as required by claim 10; and the placing of the shank (24) within a central aperture of the backing plate (14), as required by claim 18.

In response to appellant's argument (regarding claims 9 and 15) that the references fail to show a contact that "extends from the terminal base and is not frictionally couple thereto", it is noted that the features upon which appellant relies (i.e., not frictionally couple) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

For the above reasons, it is believed that the rejections should be sustained.

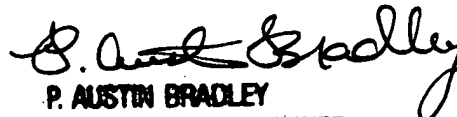
Respectfully submitted,


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February 26, 2004

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